

Appl. No. 10/723,994  
Amdt. dated July 24, 2006  
Response to Office Action mailed January 25, 2006

### **REMARKS/ARGUMENTS**

Applicants respectfully request reconsideration of this application in view of the foregoing amendments to claims and the following comments.

In the Office Action mailed January 25, 2006, pending claims 1-7, 20-25, and 27-39 were rejected under 35 U.S.C. § 103(a), as follows:

- Claims 1-7, 20-25, and 27-39, based on U.S. Patent No. 722,927 to Swift ("Swift '927");
- Claims 20-24, based on Swift '927 in view of specified "Official Notices";
- Claims 1-7, 20-25, and 27-39, based on U.S. Patent No. 749,174 to Davis ("Davis '174");
- Claims 20-24, based on Davis '174 in view of specified "Official Notices";

Applicant respectfully traverses these rejections for the reasons set forth below.

#### **Obviousness Rejections of Claims 1-7, 20-25, and 27-39 over Swift '927**

As mentioned above, claims 1-7, 20-25, and 27-39 were rejected under 35 U.S.C. § 103(a), as allegedly obvious over Swift '927, and claims 20-24 were similarly rejected over Swift '927 in view of specified "Official Notices."

Swift '927 discloses a golf-stick or driver, including a face plate B having ribs or corrugations B<sup>2</sup>, as shown in Fig. 1. These ribs or corrugations are contiguous with each other, with no separation distance between adjacent projections. This structure differs significantly from Applicants' claimed invention.

Independent claim 1 defines a golf club head including a forward striking face having an engineered texture configured to include a recessed surface and a prescribed, regular pattern of discrete, geometric shapes projecting forward from the recessed surface. The geometric shapes are defined to be spaced apart from each other by at least 0.1 mm, and each geometric shape is defined to have a volume of less than 0.0007 mm<sup>3</sup>. In addition, the recessed

Appl. No. 10/723,994  
Amdt. dated July 24, 2006  
Response to Office Action mailed January 25, 2006

surface is "*substantially planar*" and the geometric shapes are spaced apart from each other by the specified amount "*along the recessed surface*." The substantially planar recessed surface, therefore, must lie between adjacent geometric shapes. This effectively excludes patterns of geometric shapes that are contiguous with each other such that they lack any intervening portion of a substantially planar recessed surface.

Contrary to the Examiner's assertions, Swift '927 patent fails to disclose a striking face with geometric shapes that are spaced apart from each other along the recessed surface by at least 0.1 mm, and that each geometric shape is solid and has a volume of less than 0.0007 mm<sup>3</sup>. A wholesale modification of the Swift '927 golf stick, therefore, would be required to arrive at Applicants' claimed invention. For these reasons, the rejection of independent claim 1 based on Swift '927 is improper and should be withdrawn.

Independent claim 29 is directed to a wedge-type golf club head including a forward striking face having a recessed surface and a plurality of discrete geometric shapes projecting from the surface, each such shape having a specified maximum volume and being separated from adjacent shapes by a specified minimum distance.

As discussed above, Swift '927 fails to disclose a striking face having a plurality of discrete geometric shapes projecting from the surface separated from adjacent shapes by a specified minimum distance. Its geometric shapes are contiguous with each other, they are not separated from each other by the specified minimum distance along the recessed surface. A wholesale modification of Swift '927 golf stick, therefore, would be required to arrive at Applicants' claimed invention. For these reasons, the rejection of independent claim 29 based on Swift '927 is improper and should be withdrawn.

Claims 2-7, 20-25, 27, and 28 all depend from independent claim 1, and claims 30-39 all depend from independent claim 29. These dependent claims add structural features that further distinguish over the disclosure of Swift '927. For these reasons, and for the reasons set forth above with respect to independent claims 1 and 29, the rejections of these dependent claims based on Swift '927 are improper and should be withdrawn.

Appl. No. 10/723,994  
Amdt. dated July 24, 2006  
Response to Office Action mailed January 25, 2006

**Obviousness Rejections of Claims 1-7, 20-25, and 27-39 over the McKinnon Patent**

As mentioned above, claims 1-7, 20-25, and 27-39 were rejected under 35 U.S.C. § 103(a), as allegedly obvious over Davis '174, and claims 20-24 were similarly rejected over Davis '174 in view of specified "Official Notices."

Davis '174 discloses a golf putter including four striking faces having roughened surfaces, so as to have good contact with the ball. As shown in Fig. 1, the roughened surface appears to be comprised of square-like projections that are contiguous with each other, with no separation distance between adjacent projections. This structure differs significantly from Applicants' claimed invention.

Contrary to the Examiner's assertions, the Davis '174 golf putter head structure differs significantly from Applicants' claimed invention. As discussed above in connection with the obviousness rejection based on Swift '927, independent claims 1 and 29 both define a golf club head having a pattern of discrete, geometric shapes projecting from a substantially planar recessed surface, wherein such geometric shapes are spaced apart, or separated, from each other by a specified minimum amount "*along the recessed surface*." This effectively excludes patterns of geometric shapes that are contiguous with each other such that they lack any intervening portion of a substantially planar recessed surface, as disclosed in Davis '174.

For these reasons, the obviousness rejections of independent claims 1 and 29 based on Davis '174 are improper and should be withdrawn.

Claims 2-7, 20-25 and 28 all depend from independent claim 1, and claims 30-39 all depend from independent claim 29. These dependent claims add structural features that more particularly define the invention and thus further distinguish over the disclosure of Davis '174. For these reasons, and for the reasons set forth above with respect to independent claims 1 and 29, the obviousness rejections of dependent claims 2-7, 20-25, 27, 28, and 30-39 based on Davis '174 are improper and should be withdrawn.

Appl. No. 10/723,994  
Amdt. dated July 24, 2006  
Response to Office Action mailed January 25, 2006

**CONCLUSION**

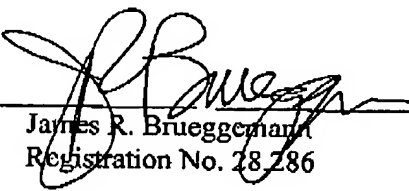
The foregoing remarks should place this application in condition for allowance. If the Examiner believes that a telephone conference with Applicants' undersigned representative might expedite the prosecution of the application, he is respectfully requested to call at the telephone number indicated below. As indicated in the accompanying transmittal form, please charge any fees due in connection with this filing to our Deposit Account No. 19-1853.

Date: July 24, 2006

Respectfully submitted,

SHEPPARD, MULLIN, RICHTER & HAMPTON LLP

By: \_\_\_\_\_

  
James R. Brueggemann  
Registration No. 28,286

333 South Hope Street, 48th Floor  
Los Angeles, California 90071  
Telephone: (213) 620-1780 x4156  
Facsimile: (213) 620-1398